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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,965	02/11/2004	Vincent Kwan	29617/CL002A	3568
4743	7590	10/08/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			FAISON, VERONICA F	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	OB
	10/776,965 Examiner Veronica F. Faison	KWAN Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Preamble***

The preamble limitation "useful for dry erase" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 USPQ 6411.

### ***Claim Objections***

Claims 7, 8 and 13 are objected to because of the following informalities: In claim 7, 8 and 13 recites a range (i.e. about 0.1 wt% and about 80 wt% or less). It is the position of the Examiner that Applicant should rewrite the range to about 0.1 wt% to about 80 wt% to clearly define the range. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000256604.

JP 2000256604 an ink composition comprising 1 to 40 percent of a colorant selected from inorganic pigments, organic pigments and colored resin balls with an average particle diameter of 0.5 to 10  $\mu\text{m}$ , 0.1 to 5 percent of a film-forming resin and 0.1 to 5 percent of a release agent. The reference further teaches 0.05 to 2 percent of a water-soluble polymer, 1 to 30 percent of a wetting agent such as ethylene glycol and

60-95 percent of water (abstract). The composition as taught by JP 2000256604 appears to anticipate the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santini et al (US Patent 5,968,241).

Santini et al teach a coloring composition comprising a polymeric dye, a dye vehicle and an anionic dyeblocker. The reference further teaches that the coloring composition may comprise one or more colorants wherein the colorant may be selected from polymeric dye, acid dyes, pigments or mixtures present in the amount of about 2 percent to about 20 percent (col. 6 lines 7-13). The dye vehicle is water or a mixture of water and alcohol or other water-miscible solvents (col. 6 lines 40-55). The film forming component may be a water-soluble resin to provide enhanced washability (col. 6 lines 64-67). The coloring composition may be used as a marker ink (col. 7 lines 36-39). The humectant is used in the marker to retard the evaporation of water from the ink solution (col. 8 lines 1-13). A surfactant may also be present in the composition which includes anionic surfactants (col. 8 lines 15-25). The reference remains silent to the size of the pigment, however when general conditions (i.e. particle size) are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing

the size, shape, proportion of shape, degree and sequence of added ingredients through routine experimentation. (*In re Rose*, 105 USPQ 137; *In re Aller* 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); *In re Dailey et al.*, 149 USPQ 47; *In re Reese*, 129 USPQ 402; *In re Gibson*, 45 USPQ 230). Therefore it would have been obvious to one of ordinary skill in the art to use pigment particle size in the range as claimed by Applicant because that particle size is well known in the art, absence evidence to the contrary.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Santini et al et al (US Patent 5,968,241) as applied to claims 1-20 and 22 above, and further in view of Bernhardt et al (US Patent 5,286,291).

Santini is described above, but fails to teach the specific surfactant set forth in claim 21.

Bernhardt teaches a composition comprising an anionic surfactant wherein the surfactant is phosphate esters (col. 4 lines 26-27).

Therefore it would have been obvious to one of ordinary skill in the art to use the anionic surfactant of Bernhardt in the composition of Santini because Santini disclose that an anionic surfactant can be used therefore any anionic surfactant (i.e. phosphate ester) may be used.

Claims 1-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santini et al (US Patent 6,040,359).

Santini et al teach a washable dry erase coloring composition comprising an acid dye or polymeric dye colorant, a dye vehicle, a release agent and an aromatic organic

sulfonate (abstract and col. 3 lines 11-13). The reference further teaches that one or more colorants may be used including pigments in the composition (col. 5 line 43-col. 6 line 41). The release agent is used to separate the film between the surface of the whiteboard and the film forming resin. The release agent is preferably a polyalkylene oxide-modified polydimethylsiloxane which is present in the amount of 1 to 30 percent by weight (col. 7 lines 35-65). The film forming component may be a water-soluble resin that provides enhanced washability and is present in the amount of 0 to 10 percent by weight (col. 8 lines 20-43). The composition may further comprise a humectant, a surfactant (i.e. anionic surfactant), a preservative, a defoamer and/or a pH regulant (col. 9 lines 37-67). The reference remains silent to the size of the pigment, however when general conditions (i.e. particle size) are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing the size, shape, proportion of shape, degree and sequence of added ingredients through routine experimentation. (In re Rose, 105 USPQ 137; In re Aller 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); In re Dailey et al., 149 USPQ 47; In re Reese, 129 USPQ 402; In re Gibson, 45 USPQ 230). Therefore it would have been obvious to one of ordinary skill in the art to use pigment particle size in the range as claimed by Applicant because that particle size is well known in the art, absence evidence to the contrary.

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### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the Examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Veronica F. Faison